02-13-04

A-E

PATENT
Docket No. 990422

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In Re Application of:	)	**For: METHOD AND APPARATUS FOR RESPONDING TO AN INCOMING CALL**
Clifton Scott	)	
Serial No.: 09/490,557	)	**Examiner: Marceau Milord**
Filed: January 25, 2000	)	**Group Art Unit: 2685**

NO | Ext Brief 3/3/04

TRANSMITTAL LETTER

Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

Dear Sir:

Enclosed for filing please find Appellant's Appeal Brief in Support of Appellant's Appeal to the Board of Patent Appeals and Interferences in triplicate. Please charge our Deposit Account No. 17 - 0026 of QUALCOMM Incorporated in the amount of $330.00 for the filing of the Appeal Brief and an additional $950.00 for a three month extension. In addition, please charge any additional fees whatsoever which may become properly due or payable, as set forth in 37 CFR 1.16 to 37 CFR 1.18 inclusive, or credit any overpayment, for the entire pendency of this application without specific additional authorization.

I hereby certify that this correspondence is being deposited with the United States Postal Service as first class mail in an envelope addressed to the Commissioner of Patents, P.O. Box 1450, Alexandria, VA 22313-1450, on:

February 11, 2004
(Date of Deposit)

Theresa M. Badet
(Name of the Person Making Deposit)

Theresa M. Badet
(Signature)

February 11, 2004
(Date of Signature)

02/19/2004 MAHMED1 00000053 170026 09490557
02 FC:1253 950.00 DA

Respectfully submitted,

Dated: February 11, 2004

By: Nicholas J. Pauley
Nicholas J. Pauley
Reg. No. 44,999

QUALCOMM Incorporated (PTO Customer No. 23696)
Attn: Patent Department
5775 Morehouse Drive
San Diego, California 92121-1714
Telephone: (858) 845-8405
Facsimile: (858) 658-2502

PATENT

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In Re Application of:	)	**For: METHOD AND APPARATUS**
Clifton E. Scott	)	**FOR RESPONDING TO AN**
	)	**INCOMING CALL**
Serial No.: 09/490,557	)	
	)	
Filed: January 25, 2000	)	**Group Art Unit: 2685**
	)	**Examiner: Marceau Milord**

APPELLANT'S APPEAL BRIEF IN SUPPORT OF APPELLANT'S APPEAL TO THE BOARD OF PATENT APPEALS AND INTERFERENCES

Commissioner of Patents
P.O. Box 1450
Alexandria, VA 22313-1450

Dear Sir:

The Appellant hereby submits, in triplicate, the following brief in support of the appeal from the final decision by the Examiner in the above-captioned case. The Appellant respectfully requests consideration of this appeal by the Board of Patent Appeals and Interferences for allowance of the above-captioned patent application.

I hereby certify that this correspondence is being deposited with the United States Postal Service as first class mail in an envelope addressed to the Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450, on:

February 11, 2004
(Date of Deposit)

Theresa Badet
(Name of the Person Making Deposit)

Theresa Badet
(Signature)

REAL PARTY IN INTEREST

The real party in interest is the assignee:

QUALCOMM Incorporated
5775 Morehouse Drive
San Diego, CA 92121

I. RELATED APPEALS AND INTERFERENCES

To the best of Appellant's knowledge, there are no appeals or interferences related to the present appeal, which will directly affect, be directly affected by, or have a bearing on the Board's decision.

II. STATUS OF THE CLAIMS

Claims 1 through 25 have been cancelled without prejudice.

Claims 26 through 30 have been finally rejected and are the subjects of this appeal.

III. STATUS OF AMENDMENTS

All amendments have been entered in the case. No claims have ben entered subsequent to the final rejection. Claims 26 through 30 are the only claims presently in the case.

IV. SUMMARY OF INVENTION

Summary of the invention by claim. Claim elements are in ***bold italic*** for readability:

Claim 26. A method of responding to a call in a wireless communication device comprising:

accepting an incoming call;

Fig. 3 Block 320

Specification page 5 line 26 "In block 320 the phone indicates the reception of an incoming call"

displaying the source of the call;

Fig 3 block 325

Specification page 5 line 26-29 "In response to the incoming call notification, the phone displays the calling phone number and/or other identifying information such as name in step 325. In step 330 flow control is determined by automatic mode status."

detecting a first input;

Fig 3 block 350

Specification Page 5 Lines 32-33 "In another embodiment of the invention, the phone may also rely upon user input before responding in step 335."

responding to the first input by providing a prerecorded message in response to the incoming call; and

Fig 3 block 355

Specification Page 6 Lines 1-7 "In step 350, the phone also sends a response audible to the calling party based on either the user input or automatically according to the variable setup configuration of the phone. Such a response is the aforementioned prerecorded message. An exemplary user input is the depression of an appropriate key or the

movement of a phone including the opening of a clamshell type phone. Step 350 may optionally be repeated to allow the user more time to respond to the calling party."

accepting a second input to terminate the prerecorded message and answer the call.

Fig 3 block 360

Specification Page 6 lines 20-22 "The phone returns to off hook - call connected condition upon receiving an input in step 360. In the preferred embodiment, this input is the user pressing the "talk" key in step 365."

Claim 27. The method of claim 26 wherein providing a prerecorded message in response to the incoming call further comprises accepting a third input to repeat the prerecorded message.

Fig 3 block 350

Specification Page 6 Lines 1-7 "In step 350, the phone also sends a response audible to the calling party based on either the user input or automatically according to the variable setup configuration of the phone. Such a response is the aforementioned prerecorded message. An exemplary user input is the depression of an appropriate key or the movement of a phone including the opening of a clamshell type phone. Step 350 may optionally be repeated to allow the user more time to respond to the calling party."

Claim 28. The method of claim 26 wherein providing the prerecorded message further comprises accessing the prerecorded message from within the wireless communication device.

Specification Page 4 lines 13-18 ". The user receiving the call presses a pre-programmed

soft key on the phone. The phone plays a prerecorded message audible only to the calling party such as, for example, "Hi, this is Joe. I'm in a meeting. Please wait a moment while I step outside to take your call." After exiting the meeting, the user presses the talk button (in this scenario) and has a conversation with the calling party."

Claim 29. The method of claim 26 wherein providing a prerecorded message in response to the incoming call further comprises selecting the prerecorded message from a plurality of prerecorded messages dependant on the source of the call.

Specification Page 6 Lines 7-12 "The response in step 350 may be a single constant response, or may rely upon user input. This response may be dependent upon the identifying information or may be independent of the information. For example, when in automatic call delay answering mode, all callers may get the single response. Optionally, a unique response may be tailored to separate calling parties."

Claim 30. The method of claim 26 wherein displaying the source of the call further comprises:
using Caller ID information to determine the source of the call; and displaying information related to the Caller ID information.

Fig 3 block 325

Specification page 5 line 26-29 "In response to the incoming call notification, the phone displays the calling phone number and/or other identifying information such as name in step 325. In step 330 flow control is determined by automatic mode status."

V. ISSUES PRESENTED FOR REVIEW

1. The Examiner has not established a Prima Face case of obviousness.

2. The proposed modifications of the Examiner change the principal of operation of a reference. According to MPEP 2143.01, if the proposed modifications change the principal of operation of a reference such modifications are not allowed as the basis of a rejection.

3. The Examiner has combined references that teach away from their combination. MPEP 2146 states references cannot be combined where reference teaches away from their combination.

VI. GROUPING OF CLAIMS

Claim 26 is an independent claim, from which all other claims depend. All issues apply to claims 26-30 equally. All claims stand or fall based on the arguments advanced below with respect to claim 26.

VII. ARGUMENT

The Examiner's rejection of claims 26-30 under 35 U.S.C. 103(a) as being unpatentable over Kennedy (US 6,405,033) in view of Brilla (US 6,389,276) is improper for reasons discussed below.

The Examiner has not established a Prima Facie Case of Obviousness. A Prima Facie Case of Obviousness has not been established for a variety of reasons as detailed below.

ISSUE 1. The Examiner has not established a Prima Face case of obviousness with respect to the claim elements.

With regard to Prima Facie Case Obviousness MPEP 2142 states:

To establish a *prima facie* case of obviousness, three basic criteria must be met. First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings. Second, there must be a reasonable expectation of success. Finally

(*Third*), the prior art reference (or references when combined) must teach or suggest all the claim limitations. The teaching or suggestion to make the claimed combination and the reasonable expectation of success must both be found in the prior art, and not based on applicant's disclosure. *In re Vaeck*, 947 F.2d 488, 20 USPQ2d 1438 (Fed. Cir. 1991).

The prior art reference (or references when combined) do not teach or suggest all the claim limitations. The Examiner has not found the claim elements in the prior art cited.

Claim 26 First Element "accepting an incoming call"

The Examiner states that the first element of claim 26 "accepting an incoming call" is met by figure 1 item 12 of Kennedy. Figure 1 item 12 of Kenendy depicts a truck having a mobile unit. There is no indication that the mobile unit accepts an incoming call, this element is not present in Kennedy.

In the passage sited by the examiner, i.e. Kennedy Column 3 lines 54-67 Kennedy states the mobile unit is used for initiating a call:

"FIG. 1 illustrates a communication system 10 that includes a number of mobile units 12 coupled to a network switching center (NSC) 14 and a number of service centers 16 by a voice network 18 and, optionally, a data network 20. Each mobile unit 12 includes at least a user interface 22 and a platform 24. In one operation, interface 22 and platform 24 enable control of the local features and functions available at mobile unit 12. In another operation, interface 22 and platform 24 enable mobile unit 12 to issue a request for enhanced services from service centers 16 using NSC 14. NSC 14 accesses stored profile tables using a service message issued by mobile unit 12 to select an appropriate service center 16. The selected service center 16 provides enhanced services to mobile unit 12 to satisfy the request."

Applicant has requested that the examiner point out exactly where in this passage or anywhere in Kennedy a mobile unit accepts a call. No where does the disclosure of Kennedy contain even the hint of accepting an incoming call.

Claim 26 Second Element "displaying the source of the call"

The Examiner states that the second element of claim 26 "displaying the source of the call" is met by element 22 of Fig. 1. Element 22 of Fig. 1 is labeled "user interface".

The Examiner also cites column 2 lines 41-53, column 3 lines 54-67 and column 4 lines 12-22. These passages are repeated below:

"Further technical advantages of the present invention include a user interface at the mobile unit having a display and a number of buttons. In one embodiment, the display presents a menu structure having one or more levels of static or dynamic menu options that facilitate requesting enhanced services from the service centers, monitoring and controlling sensors and actuators at the mobile unit, and performing any of the unique features and functions of the mobile unit. The service centers may also download to the mobile unit menu data specifying new or updated menu structures and/or associated menu options for available enhanced services. The operator of the mobile unit may navigate through and select menu options using the buttons." Kennedy column 2 lines 41-53

In this passage Kennedy does not indicate anywhere that there is an identification of the source of any call. Quite to the contrary Kennedy indicates "the display presents a menu structure having one or more levels of static or dynamic menu options that facilitate requesting enhanced services from the service centers" thereby identifying the mobile as the source of the call. There is no need to identify the source of an incoming call because the mobile initiates Kennedy's calls, and does not receive them. There is no discussion in Kennedy of incoming calls at all.

The next passage cited by the Examiner is column 3 lines 54-67 of Kennedy:

"FIG. 1 illustrates a communication system 10 that includes a number of mobile units 12 coupled to a network switching center (NSC) 14 and a number of service centers 16 by a voice network 18 and, optionally, a data network 20. Each mobile unit 12 includes at least a user interface 22 and a platform 24. In one operation, interface 22 and platform 24 enable control of the local features and functions available at mobile unit 12. In another operation, interface 22 and platform 24 enable mobile unit 12 to issue a request for enhanced services from service centers 16 using NSC 14. NSC 14 accesses stored profile tables using a service message issued by mobile unit 12 to select an appropriate service center 16. The selected service center 16 provides enhanced services to mobile unit 12 to satisfy the request." Kennedy column 3 lines 54-67.

Again there is no need to identify the source of a call because the mobile only initiates calls. There is no mention of monitoring calls in the mobile unit. There is no indication that any call is accepted.

The final passage cited by the Examiner with respect to the second element is column 4 lines 12-22 of Kennedy:

"User interface 22 includes a display 34 and a variety of buttons 36. Interface 22 enables local access to platform 24, sensors 26, actuators 28, and computing devices 30, and/or remote access to service centers 16 via NSC 14 using network 18 and, optionally, network 20. An operator of mobile unit 12 may activate a button 36 to perform any contemplated feature or function of user interface 22 and/or mobile unit 12, such as, for example, to request a desired service from a particular service center 16, or to monitor and control sensors 26, actuators 28, and/or computing devices 30." Kennedy column 4 lines 12-22.

Again the user interface is described as an input device "Interface 22 enables local access to platform 24, sensors 26, actuators 28, and computing devices 30, and/or remote access to

service centers." There is simply no indication that the mobile accepts any call, since the mobile is the source of calls.

Applicant has requested that the examiner point out exactly where in these 3 cited passages or anywhere in Kennedy displaying the source of a call is indicated. Kennedy , as clearly stated in the Abstract "Using a user interface, an operator of a mobile unit issues a request for services from one or more service centers." Obviously the mobile unit is issuing requests, and is the source, not the acceptor, of calls.

Claim 26 Fourth Claim Element "responding to the first input by providing a prerecorded message in response to the incoming call"

The Examiner cites column 4, line 55 - column 5, line 47; column 6, lines 34-55; column 9, lines 49-65; column 26, lines 35-65; and column 29, lines 43-60. Applicant will not repeat all the quoted passages, suffice it to say that in Kennedy there is no mention of a "responding to the first input by providing a prerecorded message in response to the incoming call". Kennedy describes messages that are generated, speech synthesis, and a variety of other mechanisms but there seems to be no response generated to an incoming call. Applicant has reviewed the cited passages, but fails to see the claimed element in any of them. Applicant has requested that the examiner specifically point out where this element is.

Claim 26 Fifth Claim Element "accepting a second input to terminate the prerecorded message and answer the call"

To meet this fifth claim element the Examiner cites Brilla et. al.

The Examiner states "Since the wireless network 120 has the capability to transmit command to the digital telephone 122, and it also includes a short message service server, 130 it is considered that the digital telephone 122 can be placed automatically in a call delay answering mode when it receives the command from the system." Applicant contends that saying that "the

digital telephone 122 can be placed automatically in a call delay answering mode" does not establish a Prima Facie Case of Obviousness. This contention is supported by MPEP 2143.01 states the **"FACT THAT THE CLAIMED INVENTION IS WITHIN THE CAPABILITIES OF ONE OF ORDINARY SKILL IN THE ART IS NOT SUFFICIENT BY ITSELF TO ESTABLISH PRIMA FACIE OBVIOUSNESS"**

No where in Brilla is there a hint of suggestion of terminating a prerecorded message and answering a call. Brilla is "A system for remote notification of new voicemail messages stored in a landline based voicemail system to a wireless mobile telephone." Brilla abstract

The short message server 130 cited by the Examiner provides a test message indicating that a voice mail was received at the customer premises 108. Applicant fails to see the pertinence, and is unable to understand the Examiner's arguments with respect to Brilla. Simply put Applicant finds no place in Brilla where any message is terminated in response to an input, which is the gist of claim element 5. Applicant has requested that the Examiner specifically point out anywhere in Brilla where any prerecorded message is terminated in response to an input. This fifth claim element is not found in any of the passages cited by the Examiner or anywhere else in the patent that the Applicant can find.

Since the Examiner has not identified anywhere where elements 1,2,4 and 5 of claim 26 are present in the prior art, and MPEP 2142 requires "the prior art reference (or references when combined) must teach or suggest all the claim limitations" the Examiner has not established a Prima Facie Case of Obviousness.

Even if such an element were found in Brilla, it could not be combined with Kennedy to result in Applicants claim for several reasons as discussed below.

ISSUE 2. The proposed modifications of the Examiner change the principal of operation of a reference. According to MPEP 2143.01, if the proposed modifications change the principal of operation of a reference such modifications are not allowed as the basis of a rejection.

MPEP 2143.01 states that **"THE PROPOSED MODIFICATION CANNOT CHANGE THE PRINCIPAL OF OPERATION OF A REFERENCE"** If the proposed modification or combination of the prior art would change the principle of operation of the prior art invention being modified, then the teachings of the references are not sufficient to render the claims *prima facie* obvious. *In re Ratti*, 270 F.2d 810, 123 USPQ 349 (CCPA 1959).

The Examiner has pointed to Brilla as reciting the fifth element of Claim 26 "accepting a second input to terminate the prerecorded message and answer the call"

In column 6 lines 16 – 32 Brilla states: "Hence, the present invention provides an arrangement where a voicemail subscriber on a telephone network, such as a public switched telephone network or a corporate network having a private branch exchange, may be remotely notified of new messages stored in his or voice mail box by the transmission of a notification message to a wireless telephone network in communication with a mobile telephone unit used by the voicemail subscriber."

Applicant's method of claim 26 prevents new messages from being stored. Applicant's claim 26 clearly states that an input is accepted to answer the call. If the call is answered no voicemail messages are stored. More simply put answering a call is an alternative to storing a message as a voice mail. The choices of either answering a call, or allowing it to become a voice mail are obviously mutually exclusive.

The final element of claim 6 is "accepting an input to terminate the prerecorded message and answer the call." Answering the call prevents the need for storing a message at all. If Brilla is modified so that messages are not stored then there is no need for notification of stored messages. The title of Brilla is SYSTEM AND METHOD FOR PROVIDING VOICE MAIL NOTIFICATION ... Applicant's system of call answering pre-empts voice mail, and hence the purpose of Brilla's System, the handling of voice mail notification, would be destroyed by any such modification which pre empts the need for voice mail at all.

Additionally providing a system for voice mail notification of stored, i.e. already received, messages teaches directly away from the Applicant's disclosure which prevents messages from being stored. The sixth element of claim 26 "accepting an input to terminate the prerecorded message and answer the call." prevents messages from being stored by answering the call. MPEP 2141.02 says that prior art must be considered in its entirety including disclosures that teach away from the claims. Brilla teaches away from any method for answering a call by teaching the handling of voice mail. Applicant's method of claim 26, when used, removes the necessity for handling of voice mail since no voice mail is generated when using Applicant's method. Hence Brilla cannot be used to support a *prima facie* case of obviousness.

ISSUE 3. The Examiner has combined references that teach away from their combination. MPEP 2146 states references cannot be combined where reference teaches away from their combination.

MPEP 2146 states References Cannot Be Combined Where Reference Teaches Away from Their Combination. It is improper to combine references where the references teach away from their combination. *In re Grasselli*, 713 F.2d 731, 743, 218 USPQ 769, 779 (Fed. Cir. 1983). It is obvious on its face that Kennedy cannot be combined with Brilla. Kennedy's A SYSTEM AND METHOD FOR ROUTING A CALL USING A COMMUNICATIONS NETWORK is incompatible with Brilla's SYSTEMS AND METHODS FOR PROVIDING VOICE MAIL NOTIFICATION FROM A SEPARATE VOICE MAIL SYSTEM TO MOBILE TELEPHONE. Kennedy routes calls, Brilla provides notification of stored calls. If calls are routed to a destination they are not stored for later notification. Brilla and Kennedy at their simplest are different ways of handling calls, which are not compatible. Storing a call precludes routing of the call. Further, since voice mail is a call destination, routing a call is a mutually exclusive alternative to storing a call as a voice mail. Hence the combination of Kennedy and Brilla cannot be used to support a *prima facie* case of obviousness.

ISSUE summary:

The Examiner has not established a Prima Facie Case of Obviousness for claim 26 because:

1. 4 of 5 claim elements in Applicant's claim 26 are not found in the prior art cited,
2. The proposed combination would change the operation of Brilla
3. The references not only teach away from their combination they are incompatible with each other and accordingly there can be no expectation (or possibility) of success and there can be no motivation to combine.
4. Examiners argument that "it is considered that the digital telephone 122 can be placed automatically in a call delay answering mode" is a mere unsupported assertion, which the Examiner has cited no support for other than the phrase "it is considered that." An assertion that such capability is within the skill of one skilled in the art is not sufficient to support a Prima Facie Case of Obviousness.

Because the Examiner has not established even one of the three elements required by *In re Vaeck*, 947 F.2d 488, 20 USPQ2d 1438 (Fed. Cir. 1991) the Examiners arguments are insufficient to support a Prima Facie Case of Obviousness. Additionally the methods of the references are mutually exclusive and hence cannot be combined. Additionally since the methods are mutually exclusive alternatives by their very nature they teach away from each other and cannot be combined so there could be no motivation to combine mutually exclusive art. Accordingly Claim 26 cannot be rejected and neither can claim 26's dependant claims 27-30.

VIII. CONCLUSION

In view of the foregoing, it is respectfully submitted that the application and all of the claims are in condition for allowance. Appellant hereby petitions for an extension of time to file this Appeal Brief, and if there are any fees due in connection with the filing of this Brief, please charge such fees to our Deposit Account No. 17-0026.

Respectfully submitted,

Dated: February 11, 2004

By: _____
Nicholas J. Pauley, Reg. No. 44,999

QUALCOMM Incorporated
Attn: Patent Department
5775 Morehouse Drive
San Diego, California 92121-1714
Telephone: (858) 845-8405
Facsimile: (858) 658-2502

APPENDIX OF THE CLAIMS INVOLVED IN THE APPEAL

26. A method of responding to a call in a wireless communication device comprising:

accepting an incoming call;

displaying the source of the call;

detecting a first input;

responding to the first input by providing a prerecorded message in response to the incoming call; and

accepting a second input to terminate the prerecorded message and answer the call.

27. The method of claim 26 wherein providing a prerecorded message in response to the incoming call further comprises accepting a third input to repeat the prerecorded message.

28. The method of claim 26 wherein providing the prerecorded message further comprises accessing the prerecorded message from within the wireless communication device.

29. The method of claim 26 wherein providing a prerecorded message in response to the incoming call further comprises selecting the prerecorded message from a plurality of prerecorded messages dependant on the source of the call.

30. The method of claim 26 wherein displaying the source of the call further comprises:

using Caller ID information to determine the source of the call; and displaying information related to the Caller ID information.